

### **REMARKS**

Claims 1-7 are currently in the application. Claims 1 and 5-7 are in independent form.

Claims 5-7 stand rejected under 35 U.S.C. § 112, first paragraph, as being broader in scope than their enabling disclosure. The Office Action has held that while the claimed compounds have been shown to be effective in treating prostate, colon, and gastric cancer that there is so many types of cancer that exist, there is not disclosure that such treatment would be effective in all types of cancer. In order to further prosecution, the claims have been amended to more specifically recite the types of cancer that are being treated. Reconsideration of the rejection is respectfully requested.

Claims 1-5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Katti et al. patent in view of the Flicker reference. Anticipation has always been held to require absolute identity in structure between the claimed structure and a structure disclosed in a single reference. Reconsideration of the rejection is respectfully requested.

In Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 U.S.P.Q. 81 (Fed. Cir. 1986) it was stated: "For prior art to anticipate under §102 it has to meet every element of the claimed invention."

In Richardson v. Suzuki Motor Co., Ltd., 868 F.2d 1226, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989) it was stated: "Every element of the claimed invention must be literally present, arranged as in the claim."

It is respectfully submitted that the Katti et al. patent is not considered to be prior art because the patent issued less than one year from the original filing date of the present application. Additionally, since the Katti et al. patent has the same inventive

entity as the presently pending application and is owned by the same entity as the Katti et al. patent, the patent is not considered to be prior art. Since the Katti et al. patent is not prior art to the presently claimed invention, the claims are patentable over the cited prior art and reconsideration of the rejection is respectfully requested.

The remaining dependent claims not specifically discussed herein are ultimately dependent upon the independent claims. References as applied against these dependent claims do not make up for the deficiencies of those references as discussed above. The prior art references do not disclose the characterizing features of the independent claims discussed above. Hence, it is respectfully submitted that all of the pending claims are patentable over the prior art.

It is respectfully requested that the present amendment be entered in order to place the application in condition for allowance or at least in better condition for appeal. The application is placed in condition for allowance as it addresses and resolves each and every issue that remains pending. Claims have also been amended to clearly distinguish over the prior art. The application is made at least in better condition for appeal as the amendment removes many issues thereby simplifying the issues on appeal. Further, the claims have been amended to more specifically define the invention while raising no new issues that would require any further searching. Rather, the amendments have been made in view of comments made in the Office Action that clearly distinguish the presently pending claims over the cited prior art. Hence, it is respectfully requested that the amendment be entered.

This amendment could not have been made earlier as the amendment further defines the claims over the prior art in accordance with the suggestion made in the

Office Action, the suggestion first being made in the outstanding Office Action. Hence, since there remain no further issues to be resolved, it is respectfully requested that the present amendment be entered.

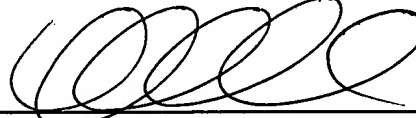
In conclusion, it is respectfully requested that the present amendment be entered in order to place the application in condition for allowance, which allowance is respectfully requested.

In view of the present amendment and foregoing remarks, reconsideration of the rejections and advancement of the case to issue are respectfully requested.

The Commissioner is authorized to charge any fee or credit any overpayment in connection with this communication to our Deposit Account No. 11-1449.

Respectfully submitted,

KOHN & ASSOCIATES, PLLC



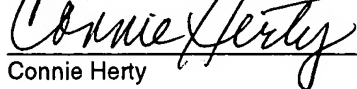
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Dated: August 25, 2004

**CERTIFICATE OF MAILING**

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Connie Herty